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PATENT
Customer No. 22,852
Attorney Docket No. 02481.1731-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Gerhard BREIPOHL et al.) Group Art Unit: 1653
)
Application No.: 09/769,487) Examiner: D. Lukton
)
Filed: January 26, 2001)
)
For: PROCESS FOR THE)
PREPARATION OF ACETYL-)
AMIDINIOPHENYLALANYL-)
CYCLOHEXYLGLYCYL-)
PYRIDINIOALANINAMIDES)

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Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION AND ELECTION REQUIREMENTS

In the Office Action dated January 30, 2003, the Examiner has required restriction and election under 35 U.S.C. § 121. Applicants respectfully respond as follows.

Pending claims 1-17 have been restricted to the following two groups:

Group I: Claims 1-9, 11, 12, and 17, drawn to methods of making compounds;

and

Group II: Claims 10 and 13-16 drawn to compounds described in the Office

Action as "synthetic intermediates."

Office Action at page 2.

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Applicants elect the claims of Group I, claims 1-9, 11, 12, and 17, with traverse. Applicants traverse on the ground that it would not be unduly burdensome to search the compounds of Group II once the processes that may employ or make those compounds have been searched. See M.P.E.P. § 803.

The Examiner also made the following election of species requirements.

A. Coupling Agent

A species must be elected for "a coupling agent used for coupling of compound III with compound IV, and for coupling of compound III with compound IVa." Office Action at page 3. Applicants elect, with traverse, dicyclohexylcarbodiimide. See specification at page 51, line 13. Applicants traverse on the ground that the claims do not define an unreasonable number of coupling agents. See 37 C.F.R. § 1.141. Moreover, it would be unreasonable to require Applicants to file many separate applications, one for each possible coupling agent.

Applicants respectfully request, should this election requirement be maintained, that the scope of the examination be broadened to include a reasonable number of species, at least including carbodiimides. See 37 C.F.R. § 1.141(a).

B. Solvent Used for Coupling

A species must be elected for "a solvent used for coupling of compound III with compound IV, and for coupling compound III with compound IVa." Office Action at page 3. Applicants elect, with traverse, N,N-dimethylformamide. See specification at page 51, line 13. Applicants traverse on the ground that the claims do not define an

unreasonable number of solvents. See 37 C.F.R. § 1.141. Further, it would be unreasonable to require Applicants to file many separate applications, one for each possible solvent.

Applicants respectfully request, should this election requirement be maintained, that the scope of the examination be broadened to include a reasonable number of species of solvents. See 37 C.F.R. § 1.141(a).

C. Anion X⁻

A species must be elected for the anion "X⁻." Office Action at page 3. Applicants elect, with traverse, the toluene-4-sulfonate anion. See specification at page 11, line 16. Applicants traverse on the ground that the claims do not define an unreasonable number of anions. See 37 C.F.R. § 1.141. In addition, it would be unreasonable to require Applicants to file many separate applications, one for each possible anion.

Applicants respectfully request, should this election requirement be maintained, that the scope of the examination be broadened to include a reasonable number of species of anions. See 37 C.F.R. § 1.141(a).

D. Catalyst for Hydrogenation

A species must be elected for "a catalyst for hydrogenation of the olefin in the compound of formula II." Office Action at page 3. Applicants elect, with traverse, rhodium(I)-(+)-(2R,4R)-1-tert-butyloxycarbonyl-4-diphenylphosphino-2-(diphenylphosphinomethyl)pyrrolidine complex. See claim 4. Applicants traverse on the ground that the claims do not define an unreasonable number of catalysts. See 37

C.F.R. § 1.141. Moreover, it would be unreasonable to require Applicants to file many separate applications, one for each possible catalyst.

Applicants respectfully request, should this election requirement be maintained, that the scope of the examination be broadened to include a reasonable number of species of catalysts, at least including chiral rhodium(I) complexes. See claim 3; see *also* 37 C.F.R. § 1.141(a).

CONCLUSION

Please grant any extensions of time required to enter this Response and charge any additional required fees related to this Response to our Deposit Account No.

06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 21, 2003

By: 

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